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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TORRES VELAZQUEZ, NORCA LIZ

ART UNIT PAPER NUMBER

1771

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,743

Applicant(s)

KNAUF, GARY H.

Examiner

Norca L. Torres-Velazquez

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>102303</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim is dependent on canceled claim 1.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by LIU et al. (US 5,510,180).

LIU et al. relates to laminates produced by extrusion coating a layer of a blend of a maleated polypropylene and a low-density polyethylene, onto a substrate layer primed with an imine primer. (Col. 1, lines 11-15) The laminates of LIU et al. have uses in packaging applications. (Col. 1, lines 27-28) The reference teaches that the substrate can be any number of

Art Unit: 1771

substrates, porous, and non-porous; and further teaches the use of metallic foils, such as aluminum foil. (Col. 2, lines 35-50) The reference further discloses that the imine primed non-reactive substrate preferably has a thickness between about 0.2 and 30 mils. (Col. 5, lines 22-23)

Although LIU et al. does not explicitly teach the claimed that the web (substrate) is lightweight it is reasonable to presume that being lightweight is inherent to the metallic foil substrate of LIU et al. Support for said presumption is found in the use of like materials (i.e. teaches the use of aluminum foil with thickness between 0.2-30 mils, the product is made by extrusion coating). The burden is upon Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed property of being lightweight would obviously have been present one the LIU et al. product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

6. Claims 13-15 and 17-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over PEER, Jr. (US 4,254,173).

PEER, Jr. relates to a secondary container packaging material that comprises a composite of a paper material laminated to a plastic film. The plastic film may be 0.25-2 mils thick and is preferably formed of polyethylene terephthalate, polyethylene, polypropylene, among others. (Abstract, also refer to Col. 2, lines 5-8) The reference defines the term "paper material" as a web of cellulosic fibers in sheet form, ranging from 0.0015-0.030 in (0.03-0.080 mm) in thickness and having a density of 5-129 lbs per 1,000 square feet (15 lbs/3000 ft² – 387 lbs/3000 ft²). (Col. 5, lines 12-16) With regards to claim 14, in which the lightweight wet is a nonwoven fabric, the Examiner interpretation of the definition of PEER, Jr. of the term "paper material" is that it encompass a nonwoven. It is noted that a nonwoven is known as a manufactured sheet,

batting, webbing, or fabric that is held together by various methods. (Dictionary of Fiber & Textile Technology, 7th edition, KOSA). PEER, Jr. does not limit their material to that produced by wet milling processes. Therefore, it is the Examiner's position that the substrate web of the reference includes a nonwoven.

Although PEER, Jr. does not explicitly teach the claimed deformations when subjected to a tension or the MD curl of claims 17 and 18, it is reasonable to presume that the deformations and MD curl are inherent to the composite of PEER, Jr. Support for said presumption is found in the use of like materials (i.e. paper webs extrusion-coated with a polyolefin). The burden is upon Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed property of MD curl of less than about 3 inches measured by the standard recited and exhibiting deformations when subjected to tension would obviously have been present one the PEER, Jr. product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

7. Claims 13, 15 and 17-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over HURST (US 3,230,135).

HURST relates to a method of applying thin films of polyethylene to paper webs or sheets. (Col. 1, lines 17-22) The reference teaches that the paper is extrusion-coated with a polyolefin film. (Col. 2, lines 32-33) The reference teaches using milk carton stock and glassine paper as packaging weight papers, and also other packaging weight papers such as kraft paper, sulfite paper, greaseproof paper, parchment, and the like. (Col. 7, lines 3-7) It is the Examiner's position that the different weight papers taught by HURST encompass papers with basis weights that could be considered "lightweight", such as parchment.

Although HURST does not explicitly teach the claimed deformations when subjected to a tension or the MD curl of claims 17 and 18, it is reasonable to presume that the deformations and MD curl are inherent to the composite of HURST. Support for said presumption is found in the use of like materials (i.e. paper webs extrusion-coated with a polyolefin). The burden is upon Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed property of MD curl of less than about 3 inches measured by the standard recited and exhibiting deformations when subjected to tension would obviously have been present one the HURST product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

8. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over HURST as applied to claim 13 above, and further in view of SELIN et al. (US 6,153,306).

HURST fails to disclose that they polymer coating comprises coextrusion of at least two layers of polymer films.

SELIN et al. relates to a coated paper, which is made by coextrusion of polylactide together with a polyolefin, such as polyethylene or polypropylene. (Abstract; Col. 3, lines 32-34) The coated paper is used in packaging materials, food packages, as well as disposable plates and cups. (Col. 3, lines 23-29)

Since both references are from the same field of endeavor, both are directed to coated papers, the purpose disclosed by SELIN et al. would have been recognized in the pertinent art of HURST.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the composite of HURST and provide it with a polymer

Art Unit: 1771

coating that comprises a coextrusion of two layers of polymer films with the motivation of enhancing the mechanical adhesion of the coating to the substrate as disclosed by SELIN et al. (Col. 1, lines 49-53).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


LIU et al. (US 4,865,908)

MOORE (US 3,900,616)

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norca L. Torres-Velazquez whose telephone number is 571-272-1484. The examiner can normally be reached on Monday-Thursday 8:00-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Norca L. Torres-Velazquez
Examiner
Art Unit 1771

September 28, 2004